UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/902,005	07/29/1997	LAURA J. BUTLER	MS1-0119US	9747

22801   7590   06/29/2010
LEE & HAYES, PLLC
601 W. RIVERSIDE AVENUE
SUITE 1400
SPOKANE, WA 99201

EXAMINER
HUYNH, SON P

ART UNIT	PAPER NUMBER
2424	

NOTIFICATION DATE	DELIVERY MODE
06/29/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

lhptoms@leehayes.com

	Application No.	Applicant(s)
	08/902,005	BUTLER ET AL.
Office Action Summary	Examiner	Art Unit	
	SON P. HUYNH	2424	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>03</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 May 2010*.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4,6-43 and 45-50* is/are pending in the application.
   4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) *1-4,6-43 and 45-50* is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
   a)☐ All   b)☐ Some * c)☐ None of:
      1.☐ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____.
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
   Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1.   A request for continued examination under 37 CFR 1.114, including the fee set

forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this

application is eligible for continued examination under 37 CFR 1.114, and the fee set

forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action

has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on

05/12/2010 has been entered.

Response to Arguments

2.   Applicant's arguments with respect to claims 1-4, 6-43, 45-50 have been

considered but are moot in view of the new ground(s) of rejection.

Applicant argues new recitations are not disclosed, taught or suggested by

Kikinis and/or Adam, either alone or in combination (page 14, last three lines). This

argument is respectfully traversed.

It is noted that The Examiner need not give patentable weight to non functional

descriptive material absent a new and unobvious functional relationship between the

descriptive material and the substrate. See In re Lowry, 32 F.3d 1579, 1583-84 (Fed.

Cir. 1994); In re Ngai, 367 F.3d 1336, 1338 (Fed. Cir. 2004) and BPAI recent final

decision in Ex parte Curry, 2005-0509 (BPAI 2005), 84 USPQ2d 1272 (Affirmed, Rule

36, Fed. Cir., slip op. 06-1003, June 2006).

In this case, the feature of "...viewport coinciding in size and position with the overlay

window." is considered to be drawn to descriptive material not functionally related to the

method. As discussed by our reviewing court, the Examiner does not need to give

patentable weight to nonfunctional descriptive material, as it "will not distinguish the

invention from the prior art in terms of patentability." In Re Ngai, at 1339. Regardless of

whether the combination of the references teach displaying viewport coinciding in size

and position with the overlay window, the limitation will not differentiate the claimed

invention from the prior art.

Nonetheless, the Examiner has found references that obviously disclose the teaching of

displaying windows/pages/screen coinciding in size and position to each other (see for

example, Kikinis: col. 4, lines 47-51, col. 8, lines 5-22; Taguchi et al. (US 4,890,096: col.

5, lines 3-9; Brusky et al. (US 6,262,713 B1) : col. 5, lines 47-55)

For reasons given above, rejections on the claims are discussed below.

Claims 5 and 44 have been canceled.

Claim Rejections - 35 USC § 101

3.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
> conditions and requirements of this title.

4.   Claims 5, 15, 24-39 are rejected under 35 U.S.C. 101 because the claimed

invention is directed to non-statutory subject matter.

Claims 5, 15, 32-39 recite" a computer readable storage system having computer-

executable instructions ...". However, the specification merely discloses data processor,

during execution of programming instructions that are storage in program memory 56

(page 17, lines 22-24) and "...forms program storage 56, or some other type of

computer-readable storage media. Application programs, containing instructions for

performing the step described herein, are contained in the storage media" (page 5-13).

Thus the claim covers a non-statutory subject matter (i.e. signal per se.) (See memo

signed by director David Kappos on 1/26/10). To avoid rejection under 101 when the

claim covers both transitory and non-transitory embodiment, the PTO suggests to add

the limitation "non-transitory" to the claim.

Claims 24-31 are rejected under 35 U.S.C. 101 as not falling within one of the four

statutory categories of invention. While the claims recite a series of steps or acts to be

performed, a statutory "process" under 35 U.S.C. 101 must (1) be tied to particular

machine, or (2) transform underlying subject matter (such as an article or material) to a

different state or thing. See page 10 of In Re Bilski 88 USPQ2d 1385. The instant

claims are neither positively tied to a particular machine that accomplishes the claimed

method steps nor transform underlying subject matter, and therefore do not qualify as a

statutory process. The claimed method comprising receiving.., is broad enough that the

claim could be completely performed mentally, verbally or without a machine nor is any

transformation apparent. For example, the step of "receiving..." could be interpreted as

receiving via mail; the step of "associating..." could be interpreted as adding/drawing

link to pages of paper; the step of "displaying..." could be interpreted as

drawings/displaying pages of payer and video stream together on a signal window of a

house or on single blackboard.

Claim Rejections - 35 USC § 112

5.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

6.   Claims 13 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention.

   Claim 13 recites "the method as recited in claim," is indefinite for failing to

particularly point out which claim it depends on.

   Claim 15 is duplicated of claim 4.

Claim Rejections - 35 USC § 103

7.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8.   Claims 1-4, 6-43 and 45-50 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Kikinis (US 5929849) in view of Adams (WO 96/10888).

Regarding claim 1, Kikinis discloses a method comprising the following steps:

"transmitting a video stream" (e.g., transmit video stream to receiver from variety

of sources- see include, but not limited to, figures 1, 2B, col. 5, lines 34-40);

"formatting supplemental data files comprising digital content in a graphical

markup language" is read on inserting/formatting related data, association data,

hyperlink, etc, comprises hyperlink, dynamic URL control routine, etc. (see include, but

not limited to, figure 2b, abstract, col. 7, lines 5-17, col. 10, lines 18-25, col. 4, lines 6-30

- Dynamic URL is notoriously well known in the computer art to be files with CGI

extension or Scripts with coded syntax in different format, i.e. HTML, DHTML (Dynamic

HTML), XTML (Extensible HTML) at the head end/server;

"wherein each supplemental data file having instruction for rendering over on the

video stream" is read on the executing the 'Dynamic URL' by a browser to render the

"emblem BMW" over the video as shown on Fig. 2C (see Fig. 3A, el. 87 and 91; Col. 8,

lines 5-37);

"transmitting the supplemental data files along with the video stream" is met by

Kikinis' disclosure of transmitting associated data, link, commands, etc. with video

stream (see include, but not limited to, Fig. 2b, 3A, el. 83).

Kikinis further discloses displaying, in conjunction, a hyperlink overlay in an

overlay window and the video stream in a viewport (interpreted as displaying hyperlink

and/or webpage on window over TV display window - see include, but not limited to,

figure 2C, col. 8, lines 1-21). Kikinis further discloses window 71 can be enlarged or

downsized, moved on the screen, or adjustable, or display entire display using pointing

device and the system of Kikinis is computer base system (see include, but not limited

to, col. 1, lines 5-53, col. 3, lines 37-40, lines 57-60, col. 4, lines 47-54, col. 8, lines 5-

22). Therefore, it would have been obvious to one of ordinary skill in the art to try to

adjust and/or move window/page to have viewport coinciding in size and position with

the overlay window in order to yield predictable results such as to display contents

user's desire.

Kikinis further discloses inserting data in the second regions for enhancing

display of the entity, such as by alternation of contrast, brightness, or color signals, or

some combination of these (col. 3, lines 4-9, col. 4, lines 19-34). However, Kikinis does

not explicitly disclose "wherein formatting comprises setting transparent background

areas of each hyperlink overlay to a key color."

Adams, in an analogous art, discloses an interactive TV system in which the

receiver also receives video stream and accompanying associated data stream of

associated data packet 84 includes an associated data payload that specifies interactive

video command and control functions that perform functions such as placement of

graphic objects on the display 12, rendering graphic objects on the display by setting

specific screen background color of the object to be transparent (set to a key color); see

include, but not limited to, figures 1-5, page 14, lines 5-14, page 18, lines 14-17, page

19, lines 11-22, page 23, line 15-page 24, line 10, page 21, lines 13-28). Thus, Adams

clearly discloses formatting comprises setting transparent background areas of each

hyperlink overlay to a key color. Therefore, it would have been obvious to one of

ordinary skill in the art at the time the invention was made to modify Kikinis with the

teaching as taught by Adam in order to yield a predictable results such provide flexible

content programming control in an interactive video system (see page 5, lines 3-13).

Regarding claim 2, Kikinis in view of Adams discloses the method as discussed in the

rejection of claim 1. Kikinis further discloses "formatting the supplemental data files in

HTML" (see include, but not limited to, col. 9, lines 24-65, figures 2B, 3A and discussion

in the rejection of claim 1).

Regarding claim 3, Kikinis in view of Adams discloses the method as discussed in the

rejection of claim 1. Kikinis further discloses a step of transmitting the supplemental

data files (e.g., dynamic URL, data related to URL, information relating the visual entity

to a specific position in the signal frame display, etc.) for display a hyperlink overlay

(see include, but not limited to, figures 2A-2C, col. 3, lines 1-9, lines 20-32; col. 4, lines

1-54 and discussion in the rejection of claim 1). However, Kikinis does not explicitly

disclose transmitting timing specifications with the supplemental data files indicating time for displaying the hyperlink overlays.

Adams discloses a timing specification (time stamp) is transmitted with associated data packets (supplemental data files) includes time stamp, i.e., time synchronization with the video stream when the graphical object is overlaid on the video stream at specific location of the screen (page 19, lines 16-22; page 23, lines 13-30).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kikinis with the teaching as taught by Adams in order to yield predictable results such as to display additional information as desired time (see include, but not limited to, page 5, lines 5-15).

Regarding claims 4 and 15, the limitations as claimed are directed toward embodying the method of claim 1 in "computer readable storage medium". It would have been obvious to embody the procedures of Kikinis in view of Adams discussed with respect to claim 1 in a "computer readable storage medium" in order that the instructions could be automatically performed by a processor.

Regarding claim 6, Kikinis in view of Adams discloses the method as discussed in the rejection of claim 1. Kikinis in view of Adams further discloses wherein the displaying step comprises launching an HTML-compatible browser to display the hyperlink overlays (see include, but not limited to, Kikinis: Col. 6, lines 5-7, col. 8, lines 10-15, and

discussion in the rejection of claim 1).

Regarding claim 7, Kikinis in view of Adams discloses the method as discussed in the

rejection of claim 1. Kikinis in view of Adams further discloses the displaying step

comprises displaying the video stream only in the areas of the hyperlink overlays that

are set to the key color (see include, but not limited to, Adams: page 20, line 15-page

21, line 25).

Regarding claims 8-10, Kikinis in view of Adams discloses the method as discussed in

the rejection of claim 1. Kikinis further discloses wherein the displaying step comprises

launching an HTML-compatible browser to display the hyperlink overlays (Col. 6, lines

5-7). Kikinis discloses displaying hyperlink overlay (Fig. 2C).

Kikinis does not explicitly disclose displaying the video stream only in the areas

of the hyperlink overlays that are set to the key color or using color keying video

hardware that display video only in display areas that are set to the key color.

Adams discloses "the step of setting transparent areas of each associated

graphic/text items overlay to the key color" in which associated data packet 84 includes

an associated data payload that specifies interactive video command and control

functions that perform functions such as placement of graphic objects on the display 12,

rendering graphic objects on the display by setting specific screen background color of

the object to be transparent (the background color is set to a key color in order to be

transparent); see page 20, line 15-page 21, line 25). Thus, Adams further discloses the

displaying the video stream only in the areas of the hyperlink overlays or displaying

using color keying video hardware that display video only in the areas that are set to the

key color (see include, but not limited to, page 14, lines 5-14, page 18, lines 14-17,

page 20, line 15-page 21, line 25, page 23, line 15-page 24, line 10). Therefore, it would

have been obvious to one of ordinary skill in the art at the time the invention was made

to modify Kikinis with the teaching as further taught by Adams in order to yield

predictable results such as to provide flexible content programming control in an

interactive video system (see include, but not limited to, page 5, lines 3-14).

Regarding claim 11, Kikinis in view of Adams discloses the method as discussed in the

rejection of claim 1. Kikinis in view of Adams further discloses including hyperlinks in the

hyperlink overlay (see include, but not limited to, Kikinis: figures 2b-3a), and displaying

content targeted by such hyperlinks in response to selecting such hyperlinks (see

include, but not limited to, Kikinis: Col. 8, line 54-col.9, line 8).

Regarding claim 12, Kikinis in view of Adams discloses the method as discussed in the

rejection of claim 1. Kikinis in view of Adams further discloses the formatting step

comprises including hyperlinks in the Hyperlink overlays (see include, but not limited to,

Kikinis: figures 2b-3a), and replacing any currently displayed Hyperlink overlay with

content targeted by such hyperlinks in response to selecting such hyperlink (see

include, but not limited to, col. 9, lines 60-col. 10, lines 55, figures 2a, 2c).

Regarding claim 13, Kikinis further discloses the formatting step comprises including

hyperlinks in the Hyperlink overlays (see include, but not limited to, figures 2b-3a), the

method further comprising an additional step of opening new viewing windows for

displaying content targeted by such hyperlink (selection of URL link to open new

windows for displaying content from webpage associated with the URL link - see

include, but not limited to, figure 2C, col. 7, line 48-col. 8, line 54).

Regarding claim 14, Kikinis in view of Adams discloses the method as discussed in the

rejection of claim 1. Kikinis in view of Adams further discloses the formatting step

comprises including hyperlinks in the hyperlink overlays (see include, but not limited to,

figures 2b-3a), the method further comprising an additional step of launching application

programs as required to render content targeted by such hyperlink (e.g., launching web

browser or other application programs as required to render content associated with

selected link – see include, but not limited to, Kikinis: col. 7, line 37-col. 8, line 53).

Regarding claims 16 and 24, the limitations that correspond to the limitations of the

limitations of claims 1-2 and 7 are analyzed as discussed in the rejection of claims 1-2

and 7. Kikinis in view of Adams also discloses the viewport and the overlay window

configured to appear as a single window (single screen/window - see include, but not

limited to, Kikinis: figures 2A, 2C; Adams: figures 1, 8).

Regarding claim 17, the limitations that correspond to limitations of claim 3 are analyzed as discussed in the rejection of claim 3.

Regarding claim 32, the limitations as claimed are directed toward embodying the method of claim 1 and/or 16 and/or 24 in "computer readable storage medium". It would have been obvious to embody the procedures of Kikinis in view of Adams discussed with respect to claims 1 and/or 16 and/or 24 in a "computer readable storage medium" in order that the instructions could be automatically performed by a processor.

Regarding claims 18, 25 and 33, the additional limitations that correspond to the additional limitations of claim 6 are analyzed as discussed in the rejection of claim 6.

Regarding claims 19, 26 and 34, the additional limitations that correspond to the additional limitations of claim 9 are analyzed as discussed in the rejection of claim 9.

Regarding claims 20-23, 28-31, 36-39, the additional limitations that correspond to the additional limitations of claims 11-14 are analyzed as discussed in the rejection of claims 11-14.

Regarding claims 27 and 35, the additional limitations that correspond to the additional

limitations of claims 25-26 are analyzed as discussed in the rejection of claims 25 and 26.

Regarding claim 40, the limitations of the system that correspond to the limitations of the method in claims 1 and 9 are analyzed as discussed in the rejection of claims 1 and 9 wherein "a broadcast source" is read on variety sources that provide video streams and related information and/or associated information to the receiver (see include, but not limited to, Kikinis: figure 1, col. 5, lines 33-55; Adams: figure 1), and the "receiver" is read on set top box or any devices that receives video stream and related information and/or associated data (see include, but not limited to, Kikinis: figure 1, col. 5, lines 33-55; Adams: figure 1). It is noted the claim 40 is broader in scope than claims 1 and 9.

Regarding claims 41-43, the additional limitations that correspond to the additional limitations of claims 2-3, 6 are analyzed as discussed in the rejection of claims 2-3 and 6.

Regarding claim 45, the limitations of a receiver that correspond to the limitations of method in claims 1, 3,10 are analyzed as discussed in the rejections of claims 1, 3, 10. Kikinis in view of Adams further discloses display hardware (e.g., TV or computer monitor) for displaying video streams and bit-map images to a user (see include, but not limited to, Kikinis: figures 1-2a, 2c; Adams: figures 1, 8);

access means is read on disk drive, memory subsystem, tuner VGA, etc. (see

include, but not limited to, Kikinis: figure 1; Adams: figures 1-6), and data processor is

read on processor and/or decoder (see include, but not limited to, Kikinis: figures 1,

Adams: figures 1-6).

Regarding claims 46-50, the additional limitations that correspond to the additional

limitations of claims 6, 11-14 are analyzed as discussed in the rejection of claims 6, 11-

14.

Conclusion

9.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

Damouth (US 5,333,255) discloses apparatus for displaying a plurality of two

dimensional display regions on a display.

Ramanathan et al. (US 5,767,850) discloses relocatable menu for accessing an

application in a graphical user interface.

Brusky et al. (US 6,262,713 B1) discloses mechanism and method for focusing

remote control input in a PC/TV convergence system.

10.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to SON P. HUYNH whose telephone number is (571)272-7295. The examiner can normally be reached on 9:00 - 6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher S. Kelley can be reached on 571-272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Son P Huynh/   June 23, 2010
Primary Examiner, Art Unit 2424